

REMARKS

Reconsideration of the Application is respectfully requested in view of the following remarks. Claims 1-2, 5-12, 15, 17, 21-23, 25-30, and 32-37 are pending in the Application. No claims have been allowed. Claims 3, 4, 13, 14, 16, 18, 19, 20, and 24, have been canceled without prejudice, and such canceled claims are being pursued in a continuation application. Claim 31 has been canceled because it is identical to claim 30. Claims 1, 2, 15, 23, 25, and 35 are independent. The amendments herein do not necessarily narrow the scope of the claims.

Cited and Other Art

Publication Number US 2003/0 191 680 A1 for U.S. Patent Application No. 10/410,307 to Dewar ("Dewar III") is entitled "Computer-Implemented System for Human Resources Management."

Publication Number US 2002/0 055 866 A1 for U.S. Patent Application No. 09/878,245 to Dewar ("Dewar II") is entitled "Computer-Implemented System for Human Resources Management."

Personal Interview

Applicants wish to thank the Examiner for his time during a personal interview with Applicants' representative Steven B. Kelber on August 2, 2004. During the interview, the outstanding Office Action, the claims, and the copying of Applicants' claims in the Dewar III reference, were all discussed.

During the interview, the Examiner noted that Dewar II is devoid of any reference, mention, or suggestion of an artificial intelligence model.

Presentation of Claims Defining Same Patentable Invention

As required by 37 CFR § 604(b), Applicants hereby identify Patent Application No 10/410,307 ("Dewar III"), which has claims identical to (i.e., copied from) Applicants' application.

Objection to claims 2 and 10

Applicants have amended claims 2 and 10 as suggested by the Action. No new matter is added thereby.

Information Disclosure Statement

Applicants include herewith an Information Disclosure Statement and request consideration by the Examiner of the references listed therein. The Information Disclosure Statement includes a copy of the provisional application ("Dewar I") relied on in Dewar II and Dewar III. During the interview, Mr. Kelber and the Examiner reviewed the disclosure of Dewar I.

***Patentability of Claims 1-2, 5-12, 15, 17, 21-23, 25-30, and 32-37
over Dewar III under § 102(e)***

The Action rejects claims 1-2, 5-12, 15, 17, 21-23, 25-30, and 32-37 under 35 U.S.C. § 102(e) as being anticipated by Dewar III. Applicants respectfully submit that the claims in their present form are allowable over Dewar III. For a 102(e) rejection to be proper, the cited art must show each and every element as set forth in a claim. (*See* MPEP § 2131.01.) However, under the rules for 102(e), Dewar III does not so show.

The rejection relies on FIGS 1-5; page 15, col. 1, last paragraph; and page 15, col. 2, lines 1-4 of Dewar III. Applicants have reviewed page 15, col. 1, last paragraph and col. 2, lines 1-4 of Dewar III, which is in the *claims* section of the Dewar III application. During the interview, the Examiner noted that it is not usual to enter a rejection based on claim language.

Upon reviewing the parent application ("Dewar II"), Applicants have discovered that the passages cited in the Action (page 15, col. 1, last paragraph; and page 15, col. 2, lines 1-4) were added to Dewar III *after* the parent application Dewar II was filed. Thus, as was discussed in the interview, these passages relied on in the rejection consist of claims that were not included in the original Dewar II filing. Accordingly, these passages are not entitled to the 102(e) date of the parent Dewar II.

Even assuming that the claims were included in the original filing of Dewar III (April 10, 2003), the passage would only be entitled to the 102(e) date of April 10, 2003. However, this 2003 date is well after the filing date of Applicants' Application (August 2, 2001).

With respect to the drawings, Applicants point out that they do not contain sufficient disclosure to anticipate the claims. Accordingly, the claims are allowable over Dewar III.

Patentability of Claims 1-2, 5-12, 15, 17, 21-23, 25-30, and 32-37 under § 101

The Action rejects claims 1-2, 5-12, 15, 17, 21-23, 25-30, and 32-37 under 35 U.S.C. § 101 as directed to non-statutory subject matter. Specifically, the Action rejects the claims as reciting a mathematical algorithm without a tangible result or practical application. Applicants respectfully submit that these claims in their present form are directed toward statutory subject matter.

The Supreme Court of the United States has interpreted § 101 broadly, stating that patentable subject matter was intended by Congress to “include anything under the sun that is made by man.” *Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980). In *State Street*, the Federal Circuit clarified the patentability of mathematical algorithms by holding that a mathematical algorithm is patentable if it produces “a useful, concrete and tangible result.” *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373 (Fed. Cir. 1998). The court in *State Street* concluded that the invention at issue, which transformed dollar values to a final share price through a series of calculations, was directed toward patentable subject matter because the final share price was a useful and tangible result. *Id.* The court in *State Street* also held that it does not matter whether the invention was “directed to a ‘machine’ or a ‘process,’ as long as it falls within at least one of the four enumerated categories of patentable subject matter.” *Id.* at 1372.

According to the rule set forth in *State Street*, the claims are directed toward statutory subject matter because they produce a useful, concrete and tangible result. Claim 1, for example, describes a method of collecting “pre-hire” and “post-hire” information from applicants and then “generating an artificial intelligence-based model” which generates “job performance criteria predictors.” A useful, concrete and tangible result produced by the invention is the artificial intelligence-based model and the job performance predictors. For example, the model and job performance predictors are useful, concrete and tangible because they “can be the basis of a hiring recommendation or other employee selection information,” as described in the Application at page 6, lines 8-9.

For clarification, Applicants have added whereby clauses in claims 1 and 15 that recite a specific utility for the respective claims; other claims already recite computer-readable media. See *In re Beauregard*, 53 F. 3d 1583, 35 USPQ2d 1383 (Fed. Cir. 1995); *In re Lowry*, 32 F.3d 1579, 32 U.S.P.Q.2d 1031 (Fed. Cir. 1994). Accordingly, the claims are directed toward statutory subject matter.

Request for Interview

If any issues remain, the Examiner is formally requested to contact the undersigned attorney prior to issuance of the next Office Action in order to arrange a telephonic interview. It is believed that a brief discussion of the merits of the present Application may expedite prosecution. Applicants submit the foregoing formal Amendment so that the Examiner may fully evaluate Applicants' position, thereby enabling the interview to be more focused.

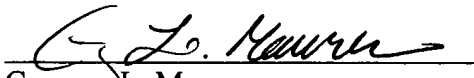
This request is being submitted under MPEP § 713.01, which indicates that an interview may be arranged in advance by a written request.

Conclusion

The claims in their present form should now be allowable. Such action is respectfully requested.

Respectfully submitted,

KLARQUIST SPARKMAN, LLP

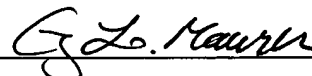
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Scarborough et al.**Application No.** 09/921,993**Filed:** August 2, 2001**Confirmation No.** 6882**For:** DEVELOPMENT OF ELECTRONIC
EMPLOYEE SELECTION SYSTEMS AND
METHODS**Examiner:** George B. Davis**Art Unit:** 2121**Attorney Reference No.** 5437-60780-01COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450**CERTIFICATE OF MAILING**

I hereby certify that this paper and the documents referred to as being attached or enclosed herewith are being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: COMMISSIONER FOR PATENTS, P.O. BOX 1450, ALEXANDRIA, VA 22313-1450 on the date shown below.

Attorney
for Applicant(s)Date Mailed August 11, 2004**INFORMATION DISCLOSURE STATEMENT PURSUANT TO
37 C.F.R. § 1.97(c)**

Listed on the accompanying form PTO-1449 and enclosed herewith are several English-language documents. Applicants respectfully request that these documents be listed as references cited on the issued patent. This Information Disclosure Statement ("IDS") is being mailed before Applicants received a final action, a notice of allowance, or an action that otherwise closes prosecution in the referenced application.

If the present application was filed after June 30, 2003, copies of United States patents and United States published patent applications do not have to be provided to the Patent Office. This requirement of 37 C.F.R. § 1.98(a)(2)(i) has been waived by the United States Patent and Trademark Office pursuant to the Official Gazette Notice on August 5, 2003 (1276 OG 55). Applicants will provide copies of such patents upon request.

Submitted herewith is a check for \$180.00 as required by 37 C.F.R. § 1.17(p) for filing this IDS in compliance with 1.97(c).

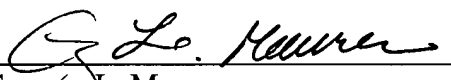
Please charge any additional fees which may be required in connection with filing this IDS, or credit any overpayment, to Deposit Account No. 02-4550. A duplicate copy of this sheet is enclosed.

The filing of this IDS shall not be construed to be an admission that the information cited in the statement is, or is considered to be, prior art or otherwise material to patentability as defined in 37 C.F.R. §1.56.

Respectfully submitted,

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cc: Docketing